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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,752	11/19/2003	Timothy L. Coder	16076-002002	8764
26161	7590	05/04/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			VAN PELT, BRADLEY J	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	CORDER ET AL.
	10/717,752	Examiner	
	Bradley J Van Pelt	Art Unit	3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,725,973. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations of breadth and scope.

***Claim Objections***

3. Claim 1 is objected to because of the following informalities: Line 25 quotes should be removed around “no mess.” Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conti (USPN 4,326,605) in view of Heller (USPN 3,565,213).

Re: claim 1, Conti discloses an automatic wire lubricating device, comprising:

a) first (29) and second (28) components each having a body section of semi-cylindrical configuration defining a portion of a contiguous cylindrical interior reservoir (13) formed by said body sections when fastened together;

b) means (30) for detachably fastening said body sections together to releasably secure said body sections of said first and second components together in order to assemble said body sections into an annular body having a cylindrical configuration and defining a central opening;

c) a coupler (23) on an outer circumferential side of said body section of said first component connected in flow communication with said interior reservoir and adapted for attachment to a soap line coming from a pump (inherent see column 4, lines 36-37);

d) means (15) defined through said body sections extending from said interior reservoir to said central opening for providing flow communication from said central opening for

providing flow communication from said interior reservoir to said central opening when said body sections are fastened together; and

e) an cylindrical nipple (20) formed by one of said axially displaced ends of said assembled body sections of said first and second components for attaching a bushing (19) thereon to keep from scaring the wire or to facilitate the attachment of a rubber grommet (19).

Re: claim 2, Conti discloses an internally threaded cylindrical clamping flange (24) formed by the other of the axially displaced ends of said assembled body sections of said first and second components for attaching about a threaded end of an externally threaded conduit for through which the wires are to be pulled (see column 4, lines 22-25).

Re: claim 6, Conti discloses said means for detachably fastening said body sections together includes: pairs of aligned sleeves (28, 29, 33, and 34) formed at opposite ends of the respective body sections; and a pair of pins each inserted through one of said pairs of aligned sleeves for releasably securing said body sections of said first and second components together to assemble said body sections into said annular body.

Re: claim 7, Conti discloses a pipe fitting (23) attached on an outer circumferential side of said body section of said first component and in flow communication with said interior reservoir; and a quick connect member which fits into said pipe fitting such that said quick connect member can be attached to a soap line coming from a pump.

Conti does not show the nipple is externally threaded.

Heller shows external threads (13).

To modify the apparatus of Conti so as to provide external threads would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the

teachings of Morton that such an arrangement improves the ease at which the device is assembled.

6. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conti (USPN 4,326,605) in view of Heller, as applied to claims 1, 2, 6, and 7, further in view of Blakeley (USPN 4,391,458).

Re: claim 3, Conti discloses the claimed invention except coupler pins formed on opposite ends of said body sections of said first and second components which fit together so as to make a tight seal of said interior reservoir when said first and second components are fastened together.

Blakeley shows coupler pins (18') formed on opposite ends of body sections of first and second components which fit together so as to make a tight seal of an interior reservoir when said first and second components are fastened together.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Conti to implement coupler pins for the purpose of insuring a tight seal alignment.

Re: claim 4, Conti, as modified by Blakely shows said interior reservoir, flow communication providing means and coupler pins are arranged to permit soap to travel 360 degrees through the interior reservoir around said body sections.

Re: claim 5, Conti discloses said flow communication providing means is a plurality of interior dispensing holes (15) circumferentially spaced apart permitting the squirting out through said interior dispensing holes onto wire being pulled through said central opening of said body sections.

10. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conti (USPN 4,326,605) in view of Oetiker (USPN 4,693,502).

Re: claim 8, Conti discloses all of the instantly claimed invention, except, tubular elements formed on opposite ends of said body sections of said first and second components which fit together so as to make a tight seal of said interior reservoir when said first and second components are fastened together.

Oetiker shows a tubular element (14), Fig. 8, formed on an opposite ends of body sections which fit together so as to make a tight seal.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Conti to include tubular elements for the purpose of improving the sealing properties of the lubrication device.

Re: claim 9, Conti discloses an internally threaded cylindrical clamping flange (24) formed by the other of the axially displaced ends of said assembled body sections of said first and second components for attaching about a threaded end of an externally threaded conduit for through which the wires are to be pulled (see column 4, lines 22-25).

Re: claim 10, the above reference combination shows flow communication providing means and tubular elements are arranged to permit soap to travel 360 degrees through the interior reservoir around said body sections.

Re: claim 11, Conti discloses said flow communication providing means is a plurality of interior dispensing holes (15) circumferentially spaced apart permitting the squirting out through said interior dispensing holes onto wire being pulled through said central opening of said body sections.

Re: claim 12, Conti discloses said means for detachably fastening said body sections together includes: pairs of aligned sleeves (28, 29, 33, and 34) formed at opposite ends of the respective body sections; and a pair of pins each inserted through one of said pairs of aligned sleeves for releasably securing said body sections of said first and second components together to assemble said body sections into said annular body.

Re: claim 13, Conti discloses a pipe fitting (23) attached on an outer circumferential side of said body section of said first component and in flow communication with said interior reservoir; and a quick connect member which fits into said pipe fitting such that said quick connect member can be attached to a soap line coming from a pump.

Re: claim 14, Conti discloses all of the instantly claimed invention except coupler pins formed on opposite ends of said body sections of the first and second components having O-rings around them and which fit together so as to make a tight seal of the interior reservoir when said first and second components are fastened together.

Oetiker shows a coupler pin (14), Fig. 8, formed on an opposite end of a body section (2) having an O-ring (15) around it and which fit together so as to make a tight seal. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Conti to include an O-ring for the purpose of improvement of the seal.

### *Conclusion*

#### *Facsimile Transmission*

7. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-7687. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP

502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

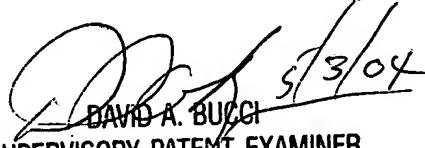
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thomas (USPN 1,049,170), Bendahan (USPN 4,498,558), and Chisholm (USPN 4,862,996).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley J Van Pelt whose telephone number is 703.305.8176. The examiner can normally be reached on M-Th 7:00-4:30, 2nd F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.2168.

BJVP   
April 30, 2004

  
DAVID A. BUCCI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600